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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,804	11/24/2003	Richard L. Kulp	GB920030079US1	5413
25259 7590 12/29/2006 IBM CORPORATION 3039 CORNWALLIS RD. DEPT. T81 / B503, PO BOX 12195 REASEARCH TRIANGLE PARK, NC 27709			EXAMINER DAM, KIM LYNN	
			ART UNIT 2112	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/29/2006	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/720,804

Applicant(s)

KULP ET AL.

Examiner

Kim-Lynn Dam

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This office action is in response to the application filed on 11/24/03.

#### ***Specification***

2. The abstract of the disclosure is objected to because it is more than one paragraph. Correction is required. See MPEP § 608.01(b).

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 29, 30, and 31 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter. Applicant's disclosure (Page 9, lines 16-26 and Page 20 line 26 to Page 21 line 4) defines a carrier medium as "electronic signal...radio frequency carrier wave...optical carrier wave". Such carrier medium is not tangible to form the basic statutory subject matter under 35 U.S.C 101. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 6-10, 15-16, 20-24, and 28-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Hama et al. (USPN 5,754,177).

Regarding claim 1, Hama disclosed a method for performing an operation on a graphic object in a display of overlapping graphic objects in a data processing system, the method comprising the steps of:

detecting the position of a pointer on said display (Abstract, lines 3-4; Col. 3, lines 37-39 and 52-54);

displaying to a user an indication of potential target objects of said operation which coincide with said pointer position (Abstract, lines 3-13; Col. 3, line 52 to Col. 4 line 3;

detecting a selection of one of said indicated potential target objects as the target object (Col. 4, lines 20-24 and line 66 to Col. 5, line 6; Col. 6, lines 14-24; and

performing said operation on said target object (Col. 1, lines 56-59).

Regarding claim 6, Hama disclosed the method of claim 1, further comprising the step of storing the positions of said graphic objects on said display and comparing said pointer position with said graphic object positions to determine which objects are coincident with the pointer (Figure 2, element 3; Col. 2, lines 44-50; Col. 3, lines 42-59).

Regarding claim 7, Hama disclosed method of claim 1, further comprising the step of

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maintaining a record of attributes relating to each of said graphic objects (Figure 2, element 3; Col. 3, lines 47-52).

Regarding claim 8, Hama disclosed the method of claim 1, wherein said displaying step comprises displaying to the user a hover window listing said graphic objects which are coincident with said pointer position (Abstract, lines 10-11; Col. 2, lines 50-53; Col. 3 line 66 to Col. 4 line 13; Col. 4, lines 33-36).

Regarding claim 9, Hama disclosed the method of claim 8, wherein said displaying step comprises displaying on the list only those graphic objects which are coincident with said pointer position and on which the operation could be performed (Abstract, lines 10-11; Col. 2, lines 50-53; Col. 3 line 66 to Col. 4 line 13; Col. 4, lines 33-36).

Regarding claim 10, Hama disclosed the method of claim 1, further comprising making said target object visible during performance of the operation on said target object (Abstract, lines 10-11; Col. 2, lines 50-53; Col. 3 line 66 to Col. 4 line 13; Col. 4, lines 33-36; Col. 1, lines 56-59).

Regarding claim 15, Hama inherently discloses the method of claim 1, wherein said step of displaying an indication of coincident graphic objects is dependent on said position of the pointer remaining the same for a certain period of time.

The limitations of claims 16, 20, 21, 22, 23 and 24 have been addressed in the rejection of claims 1, 6, 7, 8, 9, and 10 above. They are, therefore, rejected under the same basis.

Regarding claim 28 and 29: claims 28 and 29 are the program element comprising program code for executing the software tool of claim 16. They are, therefore, rejected under the same basis.

Regarding claim 30: claim 30 is the program element comprising instructions for performing the method of claim 1. It is, therefore, rejected under the same basis.

Regarding claim 31, Hama inherently disclosed a solid-state memory.

Regarding claim 32, the rejection of claim 16 is incorporated and Hama discloses a data processing system comprising a software tool according to claim 16 (Figure2).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-5 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hama et al. (USPN 5,754,177) in view of Keren et al. (USPN 6,335,733).

Regarding claim 2, the rejection of claim 1 is incorporated and Hama does not specifically disclose the step of selecting the operation to be performed on said target object. However, Keren disclosed the above limitation (Col. 5, lines 29-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Keren into the system of Hama in order to allow users to efficiently edit graphic objects.

Regarding claim 3, the rejection of claim 2 is incorporated and further Keren disclosed wherein said step of selecting an operation comprises detecting a user input identifying selection of a manipulation tool (Col. 5, lines 29-35 and 43-47). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Keren into the system of Hama in order to allow users to accurately manipulate graphic objects.

Regarding claim 4, the rejection of claim 3 is incorporated and further Keren disclosed changing the form of said pointer on said display in response to detection of said user input selection (Col. 5, lines 14-16 and 48-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Keren into the system of Hama in order to allow users to efficiently visualize the interchange of one operation to another.

Regarding claim 5, the rejection of claim 2 is incorporated and further Keren disclosed wherein said step of selecting the operation to be performed comprises selecting a source object and said step of performing the operation comprises dropping said source object onto said target object (Col. 5, lines 21-23 and 48-54). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Keren into the system of Hama in order to allow the user to directly or easily perform the operation on the target object.

Claims 17-19 have been addressed in the rejection of claims 2-5 above. They are, therefore, rejected under the same basis.

9. Claim 11 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hama et al. (USPN 5,754,177) in view of Bates et al. (USPN 5,377,314).

Regarding claim 11, the rejection of claim 10 is incorporated and Hama does not specifically disclose the step of determining whether said target object is the outermost one of said graphic objects which are coincident with the position of the pointer. However, Bates disclosed the above limitation (Col. 5, line 59 to Col. 6, line 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Bates into the system of Hama in order to allow the determination of the outermost object based on the order which objects appear in the z-axis (Bates Col. 6, lines 2-4).



Claim 25 has been addressed in the rejection of claim 11 above. It is, therefore, rejected under the same basis.

10. Claims 12-14 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hama et al. (USPN 5,754,177) in view of Bates et al. (USPN 5,377,314) and further in view of Frank et al. (USPN 5,651,107).

Regarding claim 12, the rejection of claim 11 is incorporated and neither Hama or Bates disclose wherein the step of making said target object visible comprises temporarily making at least the outermost one of said coincident graphic objects transparent. However, Frank disclosed making coincident graphic objects transparent (Abstract, lines 17-25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Frank into the system of Hama and Bates in order to make underlying data or graphics visible to users (Bates, Abstract, lines 22-25; Col. 2, lines 49-55).

Regarding claim 13, Hama, Bates and Frank substantially disclose the invention as claimed. In addition, Frank discloses the claimed wherein the outermost coincident object is a child to a parent object and the step of making the selected target object visible comprises temporarily making both the child and its parent object transparent (Abstract, lines 17-25; Col. 2, line 49 to Col. 3, line 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the

teachings of Frank into the system of Hama and Bates in order to make underlying data or graphics visible to users (Bates, Abstract, lines 22-25; Col. 2, lines 49-55).

Claims 26 and 27 have been addressed in the rejection of claims 12 and 13, above.

They are, therefore, rejected under the same basis.

Regarding claim 14, Frank inherently discloses graphic objects, which reappear automatically after the operation has been performed on said target object.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim-Lynn Dam whose telephone number is (571) 270-1408. The examiner can normally be reached on M-TH 7:30-5:00, Friday 7:30-4:00.

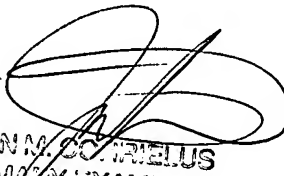
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chameli Das can be reached on (571) 272-3696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
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